

## **REMARKS**

### **I. Introduction**

Claims 1-3, 5, 6, 8-20, 23, 24, 27-31, 53, and 56-58 are pending in the application. Claims 6, 8-12, 14-20, and 29-31 are original. Claims 1-3, 5, 13, 23, 24, 27, 28, 53, and 56-58 are previously presented. No new matter is added.

Claims 2, 3, and 53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Claim 13 is rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Claims 1-3, 5, 6, 8-11, 16, 17, 23, 24, 27, 53 and 58 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,649,595 to Lewin (hereinafter "Lewin"). Claims 12-15, 56 and 57 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lewin. Claims 18-20 and 28-31 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lewin in view of U.S. Patent No. 6,460,209 to Reeder et al. (hereinafter "Reeder"). Applicant hereby traverses the rejections of the claims and respectfully request reconsideration thereof in view of the remarks set forth below.

### **II. Response to Rejections under 35 U.S.C. §112, First Paragraph – Enablement**

#### **A. Examiner's Burden**

"The examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention." *In re Wright*, 999 F.2d 1557 (Fed. Cir. 1993). "The language [of the Examiner's analysis] should focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation." MPEP §2164.04. The Examiner merely states that "the written description does not adequately describe how [the] additional section relates to the first and second section." The Examiner then provides an example of alternative arrangements of the additional sections. However, the Examiner has not provided any factor, reason or evidence to show that determining the relationship between the sections

requires undue experimentation. Moreover, as noted in the Applicant's previous response, the specification discloses at least one such relationship between sections. (See Original Specification Par. 0036). Therefore, the Examiner has not met his initial burden to establish a reasonable basis to question the enablement.

B. Enablement Standard

"The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue." MPEP §2164.01(a); *In re Angstadt*, 537 F.2d 498, 504 (Fed. Cir. 1976). Here, there are only a certain number of ways in which a section may be movable relative to another. The specification states that "all such configurations [of the sections]...are intended to fall within the scope of the systems described." (Paragraph 0036). Consequently, a person of ordinary skill in the art can decide how they want one section to move relative to another and without any experimentation make and use the claimed invention. Even assuming arguendo that some experimentation is required, such experimentation is not undue because the experimenter has a limited number of practical possibilities from which to try.

"Any part of the specification can support an enabling disclosure." *Callicrate v. Wadsworth Mfg., Inc.*, 427 F.3d 1361 (Fed. Cir. 2005). The originally filed specification describes and illustrates at least two sections moving relative to another. The specification further includes a detailed description of the arrangements of the flexible sheet and the mechanical drive units. This description, at least provides a person of reasonable skill in the art sufficient direction and assistance in making and using the claimed invention. A person of ordinary skill in the art can use this knowledge to make and use the adjustable mattress of claims 2, 3 and 53. Therefore, the specification adequately describes how the additional sections relates to the first and second section to enable one skilled in the art to make and/or use the invention as claimed without undue experimentation. Accordingly, Applicant requests withdrawal of the §112 rejection of claims 2, 3 and 53.

### **III. Response to Rejection under 35 U.S.C. §112, First Paragraph – Written Description**

Claim 13 includes subject matter directed to a controller that is programmable to recall one or more positions of the first section relative to the second section. The Office Action states that the "originally filed disclosure never provided basis [for] the controller to be programmable to recall one or more position of the first section relative to the second." Applicant respectfully disagrees. "The specification need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the [filing] date the applicant had invented what is now claimed." *All Dental Prodx, LLC v. Advantage Dental Prod., Inc.*, 309 F.3d 774 (Fed. Cir. 2002). "The claimed invention is reasonably clear when the contested language is fairly simple and intelligible, capable of being understood in the context of the patent application." *Id.* Here, the originally filed disclosure explicitly describes a mechanical drive unit within the mattress that provides a mechanical force to move the first section relative to the second section. (See Page 17, Lines 7-10). The originally filed disclosure also teaches that this mechanical drive unit may be controlled at least by wired or wireless controllers. (See Page 15, Paragraph 0048). "Further, a memory may be provided to permit storage of one or more user programmable and/or recallable orientations of one or more moveable portions of the adjustable mattress." (See Page 15, Paragraph 0048). These passages indicate, to persons skilled in the art, that the Applicant invented at least an adjustable mattress having a programmable controller to recall one or more positions of the first section relative to the second section as recited in claim 13. Accordingly, Applicant requests withdrawal of the §112 rejection of claim 13.

### **IV. Claim 1 and 27 Patentably Distinguish over Lewin**

As stated in the MPEP §2131, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Independent claim 1 is directed to an adjustable mattress having a first section and a second section overlying a common rigid planar platform. Upper surfaces of the first and second

sections together form at least a portion of a sleeping surface and are moveable relative to each other. The mattress includes a first mechanical driver unit that is connected between the rigid platform and at least one of the first section and the second section. The mattress further includes a flexible sheet having a first sheet member and a second sheet member that are disposed between the first mechanical drive unit and the first and second sections. The first and second sheet members are coextensive with the first and second sections, respectively. Also, the first sheet member is attached to the second sheet member by an articulated hinge and a force provided by the first mechanical drive unit is distributed across a region of the first section by the first sheet member associated with that section. Independent claim 27 discloses similar subject matter.

Lewin does not disclose an articulated hinge connecting the first and second sheet member of the flexible sheet as recited in the claims. The Office Action states that the flexible sheet member is "considered as the bottom of member 20" in Lewin and includes a first sheet section and a second sheet section identified, by the Examiner, as different regions on member 20. The Office Action states that "the first sheet [in Lewin] is attached to the second sheet by a hinge e.g. a living hinge." The Office Action asserts that the because "the mattress moves from Figure 4 to Figure 5," there is a hinge connecting a first and second sheet sections that allows the mattress to move. Applicant respectfully disagrees. Just because the mattress member 20 folds or bends along a folding region or crease, it does not mean that member 20 includes a hinge. Lewin does not teach or suggest any particular features of the folding region and therefore, the alleged hinge in Lewin is nothing more than a region on member 20 where the mattress can fold. Even living hinges, that are referenced by the Examiner, are characterized by a hinged region having particular structural features (e.g., reduced thickness or strength) that are positively identified. Lewin does not describe any such hinge on mattress member 20. Moreover, the claim explicitly recites the use of an articulated hinge. Such a hinge has many advantages not found mattresses that simply fold, including resiliency and durability. Thus, Lewin does not describe all the elements of claim 1 as is required by MPEP §2131 to make a proper rejection under §102.

Therefore, Applicant requests reconsideration and withdrawal of the 35 U.S.C. §102(b) rejection of independent claims 1 and 27. Claims 2, 3, 5, 6, 8-11, 16, 17, 23, 24, 53, and 58

depend on independent claims 1 and add further limitations thereto. Thus, Applicant requests reconsideration and withdrawal of the 35 U.S.C. §102(b) rejections of these claims as well.

**V. The Claims Patentably Distinguished Over the Combination of Lewin and Reeder**

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). For the reasons discussed in Section III above, Lewin fails to teach or suggest all of the elements of claim 1. Applicant has also carefully reviewed Reeder. Reeder does not cure the deficiencies of Lewin. Therefore Lewin and Reeder, alone or in combination, do not teach or suggest all the elements of claim 1. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Because claims 12-15, 18, 19, 20, 56 and 57 depend from, and are limited by, independent claim 1, Lewin and Reeder, alone or in combination, cannot teach or suggest all the elements of claims 12-15, 18, 19, 20, 56 and 57. Accordingly, there can be no prima facie case of obviousness, and the §103 rejections of dependent claims 12-15, 18, 19, 20, 56 and 57 should be withdrawn.

Furthermore, Lewin and Reeder, alone or combination, do not teach each and every element of independent claim 28. In particular, as provided in Section III above, Lewin does not teach or suggest the specific subject matter of a mattress having a flexible sheet member including a first and second sheet member attached to each other by an articulated hinge as explicitly recited in independent claim 28. Reeder also does not teach or suggest this subject matter. Accordingly, there can be no prima facie case of obviousness, and the §103 rejection of claim 28 should be withdrawn. Since claims 29-31 depends from claim 28 and add limitations thereto, §103 rejections of claims 29-31 should also be withdrawn.


**CONCLUSION**

For at least the reasons set forth above, Applicant believes the pending application is in condition for allowance.

Applicant believes that appropriate fees are provided in connection with this submission. However, if there are any other fees due in connection with the filing of this Response, please charge our Deposit Account No. 18-1945, under Order No. SMCY-P01-103 from which the undersigned is authorized to draw.

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Respectfully submitted,

By   
Vasanth Sarathy

Limited Recognition No.: L0365  
ROPES & GRAY LLP  
One International Place  
Boston, Massachusetts 02110-2624  
(617) 951-7000  
(617) 951-7050 (Fax)  
Attorneys/Agents For Applicant